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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/916,629	08/22/1997	CHAD A. COBBLEY	97-0098	3496

7590 05/21/2002

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EXAMINER
GALLAGHER, JOHN J

ART UNIT	PAPER NUMBER
1733	23

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/916629	Applicant(s)	
	Examiner	Group Art Unit	

—Th MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☑ Responsive to communication(s) filed on 19 FEBRUARY 2002.

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-22 and 40-44 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1-22 and 40-44 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). 22

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Pat nt Application, PTO-152

☑ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Acti n Summary

1. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Leo et al. in view of either Nishino et al. or Litke.

3. Claims 1-20 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Leo et al. in view of Mikuni et al. and further in view of either Nishino et al. or Litke.

4. The foregoing art rejections of paragraphs 2-3 are repeated, with the addition of O'Sullivan et al. as a secondary reference to the statement of each.

5. Claims 21-22 and 40-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Leo et al. in view of Burnett et al. and Gruber et al.

6. The (obviousness-type) double patenting rejection as set forth in paragraphs 8-9 of the last Office action is hereby reiterated and maintained.

7. Applicants' arguments filed 19 February 2002 have been fully considered but they are not deemed to be persuasive. The foregoing art rejections are adhered to essentially for the reasons of record (see paragraphs 3-6 and 10 of the last Office action), with the following being additionally advanced: With respect to applicants' comments and/or contentions made in the amendment (a) at page 16 antepenultimate line thru page 17 line 4, the point intended to be made by the Examiner in the first twelve lines of paragraph 10 of the last Office action is that, for a given invention, the (claim or) claims of which are rejected by a combination of references A, B etc., contending that reference A fails to show a certain part of the claimed subject matter, reference B does not show a certain part of the claimed subject matter, etc. (viz. a "piecemeal attack" on the references individually, AND which term does NOT apply to only one (i.e. a single) reference) does not establish patentability; (b) regarding the Di Leo et al. reference, these patentees are held to fairly disclose the (1) bonding of a semiconductor element to a lead frame utilizing a room temperature curing adhesive; (2) electrical interconnection of the aforementioned element and frame (e.g. by conductor or wire bonding); and (3) resin encapsulation of the bonded composite so formed (i.e. the "packaging" (as this term is envisioned by applicants) of this bonded composite); further (4) the lead frame of these patentees

is composed of conductive "posts" which are seen to constitute (or, at the very least, be analogous to" "fingers"; (5) adhesive is applied by these patentees between the semiconductor element and a conductive lead AND/OR A PORTION OF THE LEAD FRAME; and (6) these patentees clearly define (N.B. column 2 lines 39-40) "unfilled" (as applied through their adhesive) ONLY as containing NO METALLIC PARTICLES therein; and (c) the beneficial result(s) (e.g. thixotropy) documented in both Nishino et al. and Litke as deriving from the inclusion of a silica filler in a cyanoacrylate adhesive is held to provide sufficient motivation to combine these references with the (primary) Di Leo et al. reference; further along this line, note that prior art motivation (in the instant case, for the inclusion of a filler in a cyanoacrylate adhesive) may be different from that of an applicant and still support a conclusion of obviousness (In re Lintner, 173 USPQ 560); all of the foregoing notwithstanding, were applicants to claim one of the CONDUCTIVE (i.e. metallic) fillers disclosed by them (N.B. page 8 line 34 thru page 9 line 3 of their specification), the Di Leo et al. reference would apparently be rendered inapplicable ALTHOUGH this is not to say that there might not be other prior art that might (then) be used in its place (i.e. instead of this reference). Finally, with respect to the contentions made regarding the aforementioned double patenting rejection (N.B. page 14 lines 5-15 of the amendment),

it should be noted that (1) the copending applications are NOT employed as PRIOR ART against the instant claims, but rather as recognition that applicants have apparently voluntarily filed several applications directed to the same basic subject matter AND which separate applications are NOT the result of any restriction requirement(s) imposed by the Office, as per 35 U.S.C. § 121 and MPEP § 804.01; further, applicants are requested to submit updated copies of the claims of these two copending applications (as they are or may be amended), as was done for the copending application referred to in § (2), immediately following; and (2) the allowed ARTICLE claims of S.N.: 09/274,128 (now matured into U.S. Patent 6,353,268) are seen NOT to conflict with the instant method claims.

9. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED

STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) ~~305-3599.~~ 872-9311

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.

JJGallagher:cdc

May 15, 2002

JOHN J. GALLAGHER
PRIMARY EXAMINER
ART UNIT 1733